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REMARKS

2       Claims 2-10 have been cancelled without prejudice or  
3 disclaimer and claims 1, 11 and 17 have been amended.

4       Applicant respectfully requests further examination and  
5 reconsideration of claims 1 and 11-20 now pending in the  
6 application.

7       In the event that this specification or claims should  
8 require any further amendment, the kind assistance of the  
9 Examiner in entering an Examiner's amendment will be greatly  
10 appreciated. It is suggested that such amendment may be  
11 optionally supplemented by a phone conversation and confirmed  
12 by form PTOL-327, Box 4b, so as to expedite the formal  
13 allowance of this application.

14       The last Office Action mailed December 4, 2003 has been  
15 carefully considered and indicates that:

16           a) Claims 1-20 are rejected under  
17               35 U.S.C. 101 because the  
18               claimed invention is directed  
19               to nonstatutory subject matter;  
20               and

21           b) Claims 1-20 are rejected under  
22               35 U.S.C. 102 as being clearly  
23               anticipated by Brizendine et  
24               al.

25       In response to the Examiner's rejection of claims 1-20  
26 under 35 U.S.C. 101 because the claimed invention is directed  
27 to nonstatutory subject matter, applicant respectfully  
28 disagrees. Applicants respectfully submits that claims 1-20  
29 are directed to statutory subject matter, as confirmed by the  
30 Examiner's further rejection thereof under 35 U.S.C. 102(e).

1        In view of the argument presented supra, applicant  
2 respectfully submits that the Examiner's grounds for the  
3 rejection of claims 1-20 under 35 U.S.C. 101 because the  
4 claimed invention is directed to nonstatutory subject matter  
5 no longer appear to be applicable and applicant therefore  
6 respectfully requests that the Examiner withdraw this  
7 rejection.

8        In response to the Examiner's rejection of claims 1-20  
9 under 35 U.S.C. 102 as being clearly anticipated by Brizendine  
10 et al., applicant has:

- 11      1. Cancelled claims 2-10 without prejudice or disclaimer.
- 12      2. Amended claim 1 to include the limitations of cancelled  
13        claims 2-10.
- 14      3. Amended claim 11 to reflect proper dependency

15        Applicant respectfully submits that pursuant to 37 CFR  
16 1.111(c), amended claim 1 defines the following advantageous  
17 distinctive features that distinguish over and avoid the prior  
18 art:

- 19        a)     "determining if there is a  
20        problem getting the check to  
21        the school" [Emphasis added];
- 22        b)     "sending, by the at least one  
23        of the program vendor and the  
24        credit card issuer, the check  
25        directly to the credit card  
26        holder, if answer to step t) is  
27        yes" [Emphasis added]; and
- 28        c)     "forwarding, by the credit card  
29        holder, the check to the  
30        school, if step u) is carried  
31        out" [Emphasis added]

32        It was decided in In re Miller, 169 USPQ 597 (CCPA 1971)  
33        that each and every limitation, inter alia those discussed  
34        supra, must be met in determining patentability:

1           "All words in a claim must be  
2           considered in judging the  
3           patentability of that claim  
4           against the prior art." [at  
5           600] [Emphasis added]

6       In this same regard, the Examiner's attention is  
7       respectfully directed to the decisions in In re Fuetterer, 138  
8       USPQ 217 (CCPA 1963); and In re Ludke and Sloan, 169 USPQ 563  
9       (CCPA 1971).

10      When the method of providing a credit card driven tuition  
11     incentive award program of the present invention is designed  
12     in accordance with the advantageous distinctive features of  
13     amended claim 1 discussed supra, *inter alia* the school  
14     receives the check even if the program vendor or the credit  
15     card issuer has a problem getting the check to the school.

16      Even though the advantageous feature of the present  
17     invention discussed supra may not have been disclosed and  
18     discussed specifically in the specification of the patent  
19     application as it was originally filed, it still must be  
20     relied upon as evidence of patentability, as was decided in  
21     In re Chu, 66 F.3d 292, 36 USPQ.2d 1089 (Fed. Cir. 1995),  
22     where the Court held:

23           "Board of Patent Appeals and  
24           Interferences erred, in  
25           upholding...rejection of  
26           applicant's claims, by  
27           concluding that claims'  
28           disclosure was matter of  
29           "design choice," and that the  
30           applicant's evidence and  
31           arguments to contrary are not  
32           present in specification and  
33           are therefore unpersuasive,  
34           since board is required to  
35           consider totality of record and  
36           is not free to disregard  
37           evidence and arguments  
38           presented by applicants, and

1 since there is no support for  
2 proposition that evidence  
3 and/or arguments  
4 traversing...rejection must be  
5 contained within specification,  
6 given that [unpatentability] is  
7 determined by totality of  
8 record including, in some  
9 instances most significantly,  
10 evidence and arguments  
11 proffered during give-and-take  
12 of ex parte patent  
13 prosecution." [at 1090]  
14 [Emphasis added];

15 "Because the Board was required  
16 to consider the totality of the  
17 record, the Board was not free  
18 to disregard the evidence and  
19 arguments presented by Chu in  
20 response to the...rejection.  
21 Additionally, the Board erred  
22 in apparently requiring Chu's  
23 evidence and arguments  
24 responsive to the...rejection  
25 to be within his specification  
26 in order to be considered. To  
27 require Chu to include evidence  
28 and arguments in the  
29 specification regarding whether  
30 placement of the SCR catalyst  
31 in the bag retainer was a  
32 matter of "design choice" would  
33 be to require patent applicants  
34 to divine the rejections the  
35 PTO will proffer when patent  
36 applications are filed." [at  
37 1094] [Emphasis added]; and

38 "We have found no cases  
39 supporting the position that a  
40 patent applicant's evidence  
41 and/or arguments traversing  
42 a...rejection must be contained  
43 within the specification.  
44 There is no logical support for  
45 such a proposition as well,

1 given that [unpatentability] is  
2 determined by the totality of  
3 the record including, in some  
4 instances, most significantly,  
5 the evidence and arguments  
6 proffered during the give-and-  
7 take of ex parte patent  
8 prosecution." [at 1095] [Emphasis  
9 added]

10 And, even though the present invention may be considered  
11 simple and accomplishes only a small but genuine improvement  
12 by some is not sufficient reason to deny it patent protection,  
13 as was decided in Schnell et al. v. The Allbright-Nell Company  
14 et al., 146 USPQ 322 (Court of Appeals, Seventh Circuit 1965),  
15 where the Court held:

16 "Device seems simple...in light  
17 of patentee's teaching, but it  
18 evidently was not...at time of  
19 invention; those working in the  
20 field did not accomplish  
21 patentee's results; that fact  
22 supports conclusion that  
23 patentee achieved patentable  
24 invention." [at 322] [Emphasis  
25 added]; and

26 "This now seems simple...in the  
27 light of the Schnell teaching,  
28 but is was evidently not at  
29 all...at the time of the  
30 invention. Those working in  
31 the field did not accomplish  
32 Schnell's results. That fact  
33 supports the conclusion that  
34 Schnell achieved patentable  
35 inventions. Pyle Nat. Co. v.  
36 Lewin, 7 Cir., 1937, 92 F.2d  
37 628, 630, 35 USPQ 40, 42." [at  
38 324] [Emphasis added]

39 The Board of Appeals expressed the same concept when it  
40 held in Ex parte Grasenick and Gessner, 158 USPQ 624 (Patent  
41 Office Board of Appeals 1967), that:

1           "Improvement over prior art,  
2       even though it be simple...is  
3       patentable....[at 624]  
4       [Emphasis added]; and

5           "This rejection is in error.  
6       An improvement over the prior  
7       art, even though it be simple  
8       ...is patentable....The  
9       examiner has neither cited  
10      evidence establishing the  
11      [unpatentability] of  
12      appellant's modification of the  
13      prior art nor demonstrated that  
14      the improved results claimed by  
15      appellants are not available  
16      from their construction." [at  
17      624] [Emphasis added]

18       Attention is also respectfully directed in this regard  
19      to the decisions in Mercantile National Bank of Chicago et al  
20      v. Quest, Inc. et al. DC., N.D. Indiana, 166 USPQ 517, In re  
21      Shelby, 136 USPQ 220, and In re Irani and Moedritzer, 166 USPQ  
22      24, which all indicate that simplicity does not operate as a  
23      bar to patentability.

24       Applicant respectfully submits that when issuing a 102  
25      rejection all of the same elements must be found in exactly  
26      the same situation and united in the same way to perform the  
27      identical function in the prior art patent, as was decided in  
28      Kockum Industries, Inc. v. Salem Equipment, Inc., et al., 175  
29      USPQ 81 (Court of Appeals, Ninth Circuit 1972), where the  
30      Court held:

31           "Anticipation is strictly a  
32       technical defense. Unless all  
33       of the same elements are found  
34       in exactly the same situation  
35       and united in the same way to  
36       perform the identical function  
37       in a prior pleaded patent,  
38       there is no anticipation."  
39           Stauffer v. Slenderella Systems

of California, 254 F.2d 127, 128, 115 USPQ 347, 348-349 (9th Cir. 1957); National Lead Company v. Western Lead Products Company, 324 F.2d 539, 544, 139 USPQ 324, 327-328 (9th Cir. 1963)." [at 82, footnote 1] [Emphasis added]

9 Furthermore, the Examiner's interpretation of claim  
10 language must be reasonable, as was decided in In re Morris,  
11 43 USPQ.2d 1753 (Fed. Cir. 1997), where the Court held:

"...when an examiner issues a 102 rejection, the applicant has an obligation to demonstrate that the examiner's interpretation of the claim language was unreasonable."

19           Additionally, it is well settled that in order for a  
20 rejection under 35 U.S.C. 102 to be valid, each and every  
21 limitation, inter alia those discussed supra, must be met by  
22 a single reference, as was supported in Scripps Clinic &  
23 Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18  
24 USPO.2d 1001, 1010 (Fed. Cir. 1991), where the Court held:

"Anticipation under 102 requires identity of invention. The claimed invention, including each element thereof as described in appropriately construed claims, must have been disclosed...in a single reference." [Emphasis added]

33 And, in In re Schreiber, 128 F.3d 1473, 44 USPQ.2d 1429  
34 (Fed. Cir. 1997), where the Court held:

"...to anticipate a claim, a prior art reference must disclose every limitation of the claim..." [Emphasis added]

1 Note should also be taken in this regard to the decisions  
2 in Elmer v. ICC Fabricating, 67 F.3d 1571, USPQ.2d 1417 (Fed.  
3 Cir. 1995); Beachcombers, Int'l, Inc. v. Wilde Wood Creative  
4 Prods., Inc., 31 F.3d 1154, 1160, 31 USPQ.2d 1653, 1658 (Fed.  
5 Cir. 1994); Standard Havens Prods., Inc. v. Gencor Indus.,  
6 Inc., 953 F.2d 1360, 1369, 21 USPQ.2d 1321, 1328 (Fed. Cir.  
7 1991); Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d  
8 1264, 1267, 20 USPQ.2d 1746, 1748 (Fed. Cir. 1991); and In re  
9 Spada, 911 F.2d 705, 708, 15 USPQ.2d 1655, 1657 (Fed. Cir.  
10 1990).

11 Moreover, for a reference to disclose each and every  
12 element of a claim, it must disclose it with sufficient  
13 clarity to prove its existence, as was decided in Motorola,  
14 Inc. v. Interdigital Technology Corporation, 121 F.3d 1461,  
15 43 USPQ.2d 1481 (Fed. Cir. 1997), where the Court held:

16 "...for a prior art reference  
17 to anticipate a claim, the  
18 reference must disclose each  
19 and every element of the claim  
20 with sufficient clarity to  
21 prove its existence in the  
22 prior art...that presumed  
23 knowledge, however, did not  
24 grant a license to read into  
25 the prior art reference  
26 teachings that were not  
27 there." [Emphasis added]

28 Applying the case law discussed supra to Brizendine et  
29 al. in view of advantageous distinctive features a), b), and  
30 c) of amended claim 1 discussed supra, it is revealed that  
31 Brizendine et al. do not teach "determining if there is a  
32 problem getting the check to the school" [Emphasis added],  
33 "sending, by the at least one of the program vendor and the  
34 credit card issuer, the check directly to the credit card  
35 holder, if answer to step t) is yes" [Emphasis added], and

1       "forwarding, by the credit card holder, the check to the  
2       school, if step u) is carried out" [Emphasis added] as required  
3       by advantageous distinctive features a), b), and c) of amended  
4       claim 1, but rather teach that the holding bank sends the  
5       funds to the educational institution and are silent as to how  
6       the educational institution would get the funds if the holding  
7       bank had a problem getting the funds to it, i.e., Brizendine  
8       et al. are silent as to a contingency plan for how the  
9       educational institution would get the funds if the holding  
10      bank had a problem getting the funds to it, as shown in FIG.  
11      14 of Brizendine et al. and as discussed at col. 13, lines 18-  
12      23 of Brizendine et al. where it is disclosed:

13                 "....the club 110 delivers a  
14                 request to the holding bank 170  
15                 requesting that the holding  
16                 bank transfer appropriate  
17                 monetary funds from the  
18                 member's trust account to the  
19                 indicated educational  
20                 institution. In event 1406,  
21                 the holding bank transfers the  
22                 requested funds from the  
23                 member's trust account to the  
24                 educational institution."  
25                 [Emphasis added]

26       With this arrangement of Brizendine et al., the  
27       educational institution does not receive the check if the  
28       holding bank has a problem getting the check to the  
29       educational institution.

30       If the Examiner, however, attempts to reject claims 1-20  
31       under 35 U.S.C. 103 by merely founding individual features  
32       separately and combining them in light of applicant's  
33       disclosure in a piecemeal manner by using applicant's own  
34       disclosure as though it were prior art, a valid approach would

1 not be met in supporting a holding of obviousness, as decided  
2 in In re Kamm and Young, 17 USPQ 298 ff, where the Court held:

3 "The rejection here runs afoul  
4 of a basic mandate inherent in  
5 section 103 - that a piecemeal  
6 reconstruction of the prior art  
7 patents in the light of  
8 appellants' disclosure shall  
9 not be the basis for a holding  
10 of obviousness." [Emphasis  
11 added]

12 And, in In re Stephens, Wenzl, and Browne, 145 USPQ 656,  
13 where the Court reversed a rejection on a combination of  
14 references and held:

15 "References may not be combined  
16 indiscriminately and with  
17 guidance from applicant's  
18 disclosure to show that the  
19 claims are unpatentable."  
20 [Emphasis added]

21 And, in Panduit Corp. v. Burndy Corp. et al., 180 USPQ  
22 498, where the Court held:

23 "Inquiry into the patentability  
24 must be directed toward subject  
25 matter as a whole and not to  
26 elements of a combination and  
27 their individual novelty..."  
28 [Emphasis added]

29 Applicant has provided clear and convincing evidence that  
30 neither Brizendine et al. nor for that matter any of the  
31 references cited by the Examiner, accomplish applicant's  
32 result of providing an efficient method of providing a credit  
33 card driven tuition incentive award program that, inter alia  
34 allows the school to receive the check even if the program  
35 vendor or the credit card issuer has a problem getting the  
36 check to the school.

1       Therefore a holding of unpatentability cannot be made  
2       out, as was decided by the Board of Appeals in Ex parte  
3       Tanaka, Marushima and Takahashi, 174 USPQ 38, where the Board  
4       held:

5                 "Claims are not rejected...if  
6                 the prior art devices do not  
7                 accomplish applicant's  
8                 result." [Emphasis added]

9       And, in In re Wright, 122 USPQ 522 (1959), where the  
10      Court held:

11                 "....the mere aggregation of old  
12         elements that did not perform  
13         a different function is not a  
14         patentable invention, but that  
15         a novel combination of old  
16         elements which cooperate with  
17         each other to produce a new or  
18         useful result or a substantial  
19         increase in efficiency is  
20         patentable." [Emphasis added]

21       And, further in the en banc decision in In re Dillon, 919  
22      F.2d 688, 692 (Fed. Cir. 1990), where the Court held:

23                 "....a prima facie case of  
24         [unpatentability] requires that  
25         the prior art suggest the  
26         claimed compositions'  
27         properties and the problem the  
28         applicant attempts to solve."  
29         [Emphasis added]

30       In this same regard, the Examiner's attention is  
31       respectfully directed to the decisions in In re Halleck, 164  
32      USPQ 647 (CCPA 1970); and Kockum Industries, Inc. v. Salem  
33      Equipment, Inc., 175 USPQ 81 (9th Cir. 1972).

34       In view of the cancellation of claims 2-10 without  
35       prejudice or disclaimer, the amendment made supra to claim 1  
36       to include the limitations of cancelled claims 2-10, the  
37       amendment made supra to claim 11 to reflect proper dependency,

1 and the arguments presented supra, applicant respectfully  
2 submits that the Examiner's grounds for the rejection of  
3 claims 1-20 under 35 U.S.C. 102 as being clearly anticipated  
4 by Brizendine et al. no longer appear to be applicable and  
5 applicant therefore respectfully requests that the Examiner  
6 withdraw this rejection.

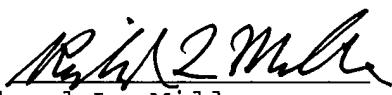
7 In view of the foregoing remarks and amendments, it is  
8 believed that claims 1 and 10-20 are in condition for  
9 allowance.

10 Reconsideration and a favorable action are now kindly  
11 requested.

12

13                   Respectfully submitted,

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BY:   
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